

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)																		
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] - via EFS-Web filing.</p> <p>on <u>July 10, 2008</u></p> <p>Signature <u>/Trisha M. Beachy-Bryant/</u></p> <p>Typed or printed name <u>Trisha M. Beachy-Bryant</u></p>		Application Number	Filed																	
		09/765,112	January 18, 2001																	
		First Named Inventor																		
		Lang																		
		Art Unit	Examiner																	
		1797	Patricia K. Wright																	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u>/Stephen L. Grant/</u></td></tr><tr><td></td><td>Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td><u>Stephen L. Grant</u></td></tr><tr><td></td><td>Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,390</u></td><td><u>614-792-5555</u></td></tr><tr><td></td><td>Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td><u>July 10, 2008</u></td></tr><tr><td></td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <table border="1"><tr><td><input checked="" type="checkbox"/> *Total of <u>3</u> forms are submitted.</td></tr></table>				<input type="checkbox"/> applicant/inventor.	<u>/Stephen L. Grant/</u>		Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Stephen L. Grant</u>		Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,390</u>	<u>614-792-5555</u>		Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>July 10, 2008</u>		Date	<input checked="" type="checkbox"/> *Total of <u>3</u> forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 09/765,112

Filed: 18 January 2001

Examiner: Wright, Patricia K.

Inventor: Lang

Art Unit: 1797

Title: ANALYZER SYSTEM AND  
DRIVE MECHANISM FOR  
SAME

Attorney MTI 1877-141  
Docket No.:

**Filed electronically on 10 July 2008**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant respectfully requests a pre-appeal brief conference review of this case.

The Response filed on 4 December 2007 substantially sets forth the issue which will need to be resolved on appeal if not resolved by the Pre-Appeal Brief Conference. As the applicant has not had an opportunity to address statements by the Patent Office in the final rejection of 13 February 2008, applicant respectfully includes a response to the statements.

The pending claims in the case are claims 2-29 and 35-38. Of these, only claim 35 (directed to an analyzer system for immersing at least two instruments into a sample and removing the instruments therefrom) is independent.

In the 13 February Office Action, the Patent Office has objected to claim 35 and the specification because the applicant has amended the claim to recite "an instrument holder comprising a holder device with at least two receptacles, each receptacle arranged to receive and hold one of the at least two instruments." It is the Patent Office's opinion that the term "receptacle" is not enabled by the specification. The specification as filed, at page 13, lines 22-26, states that the holding ring has "receiving holes 16 for holding various elongated instruments." Webster's New Collegiate Dictionary (© 1980) defines "receptacle" as "one that receives and contains something."

The quoted citation covers both the “receiving” and “holding” (“containing”) function, so the term is fully enabled by the specification.

Applicant respectfully asserts that the Patent Office has not made a *prima facie* case of obviousness under 35 USC 103(a) with regard to either the rejection made by combining Ohlin ‘212 with Harris ‘122 or the rejection made based on Ambers ‘280 by itself. Applicant will address each of these rejections.

Ohlin ‘212 combined with Harris ‘122

First, with respect to the combination of Ohlin ‘212 with Harris ‘122, applicant respectfully notes that this particular combination, while not made in the first Office Action in this case (dated 3 September 2003), was made in the second Office Action (dated 18 May 2004). The combination has been maintained ever since that point, despite several arguments by the applicant.

When initially proposed by the Patent Office, the combination of Ohlin ‘212 with Harris ‘122 was made to provide a “jet orifice”, an element admitted by the Patent Office as not being found in Ohlin ‘212. Detailed Action of 18 May 2004, page 3, first full paragraph. At that time, as now, a jet orifice is a required element of the washing device.

The applicant’s response of 18 August 2004 argued that Ohlin ‘212 is not capable of washing two instruments simultaneously. At Fig. 3, Ohlin ‘212 clearly shows a reservoir 32 of wash liquid maintained in the cleaning device. To maintain the reservoir, there must be a close spatial relationship established between bore 26 and probe portion 19, which combine to form annular space 27. This is in contrast to the fact that Ohlin ‘212 may, as has been relied upon by the Patent Office on several occasions, state that “the shape of the bore 26 and the relative dimensions of the bore 26 and the probe portion 19 to be cleaned are not very critical.” Ohlin ‘212, col. 3, lines 33-35.

Applicant has two comments on this. First, as has been argued by the applicant in the past, an “annular space” implies that only a single instrument passes through the bore, since an “annulus” is a ring-like structure. The space between bore 26 and two or more probes would not be “annular.”

Second, and contrary to the quotation cited above, Ohlin '212 states, in the same paragraph, that "naturally, the suction applied to the bore has to be adequate to ensure that no wash liquid drops from the bore 26 into the sample tube 15 or to the support surface 12." Ohlin '212, col. 3, line 42-45. This again infers that the Ohlin '212 cleaning device can only accommodate a single probe, and that the single probe must be carefully sized relative to the bore. The modification of Ohlin '212 to achieve the claimed invention would not be obvious, as it would require handling at least two probes and there would be no reason to seek out the jet orifice that is used to adequately wash the at least two probes.

Simply stated, Fig. 3 of Ohlin '212, the use of the term "annular space" and the statement at col. 3, lines 42-45 are in conflict with the quote that the Patent Office has relied upon about the non-criticality of the shape and relative dimensions of the bore and the probe, and one of ordinary skill would dismiss the non-criticality statement as a self-serving attempt to extend the scope of the disclosure without providing enablement.

Further, while Harris '122 may show jet orifices for washing, Harris '122 lacks any teaching of the simultaneous cleaning of at least two aspiration needles (corresponding to the at least two instruments of claim 35) with a single set of jet orifices. Note, for example, Fig. 14 of Harris '122.

Ohlin '212 is an old reference, filed 40 years ago and issuing 37 years ago. If the modifications that are claimed in claim 35 are as obvious as claimed by the Patent Office, it would seem that an anticipatory reference, that is, one showing the cleaning of at least two instruments, would have issued during the ensuing time and that it would be made of reference by the Patent Office.

#### Ambers '280

The Patent Office posits that Ambers '280 possesses all limitations of claim 35, except for the holder element having at least two receptacles, but that this limitation is a mere duplication of parts that would be obvious to one of ordinary skill. Applicant respectfully asserts that the Patent Office analysis ignores the fact that Ambers '280 teaches placing the "wiper body 130" (the receptacle) into a "firmly seated" relationship with the "rinse adaptor 50" (the washing device), as described at Col. 6,

lines 54-59, then the washing device would also have to be duplicated, even though this would be outside the scope of claim 35, which requires at least two receptacles but only one washing device.

The Patent Office has also taken the position in the 13 February Office Action that the term "hold" in claim 35 is sufficiently broad to be defined as "to enclose and to keep in bounds." By adopting this factually unsupported definition, the Patent Office asserts that the wiper grommet 130 of Ambers '280 "holds" the instrument tube 24. The Ambers '280 specification, which the Patent Office may not rewrite to suit its purposes, does not support the assertion. According to Col. 4, lines 22-24, the tube 24 has an outer diameter of about 1 millimeter. At Col. 4, lines 51-56, wiper 130 has a through passage 132 of also about 1 millimeter. Through passage 132 has spaced lubrication chambers 144, 146 positioned along through passage 132. Col. 4, lines 58-59. It would be applicant's position that instrument tube 24 is "held" by support block 108 (Col. 4, lines 18-19 says "a support block 108 to which intake tube 24 is *fixedly secured*" [emphasis added]).

A favorable consideration of these arguments is respectfully requested, as this case is now exceeding seven years of pendency.

While certainly not dispositive, applicant respectfully notes that the corresponding application has been issued as European Patent 1118861 in a prosecution where none of Ohlin '212, Harris '122 or Ambers '280 was cited by the Examiner.

Respectfully submitted,

Date: 10 July 2008

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